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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,261	07/13/2001	John MacAlister	1965-1-3	4870
7590 12/24/2008 John MacAlister The MacAlister Consultancy Clockhouse One Rookery Park , Yoxford Suffolk, GBN 1P17 3HQ UNITED KINGDOM			EXAMINER NORDMEYER, PATRICIA L	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 12/24/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/005,261

Applicant(s)

MACALISTER ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-9, 14-18, 25-28 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 14-18, 25-28 and 31-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Reopening of Prosecution

1. Applicant's request for reconsideration by the submission of new arguments in the response dated October 20, 2008 has been received. New rejections and responses to the arguments are stated below.

Claim Objections

2. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of claim 5 is already present in independent claim 1.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 5 – 9, 16, 17, 25- 28 and 33 - 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendershot (USPN 4,862,944).

Hendershot discloses a mount (Abstract, lines 3 – 6) releasably adhered to a single sheet of a backing material (Column 2, lines 45 – 54), the mount consisting of a single layer of plastic such as PVC (Column 2, lines 10 – 16, wherein PVC is a vinyl material) and being a mount for mounting a sheet object to glass (Figure 2, #12 and 18), and comprising a body having a first surface carrying an adhesive coating (Figure 2, #18a and 20) which adheres the mount to part of the surface of a sheet object to form a mountable arrangement (Figure 2, #16 and 20), and a second surface which secures such a mountable arrangement directly to glass without adhesive (Figure 2, #18b) as in claim 1. With regard to claim 4, the first and second surfaces of the mount are mutually opposite (Figure 2, #18a and 18b). For claim 5, the first surface of the mount adheres the mount to only a part of one surface of the sheet object to form the mountable arrangement (Figure 2 and 3, #18a). Regarding claim 6, the mount releasably secures, the mountable arrangement directly to glass (Figure 2 and 4, #12; Column 2, lines 10 – 16). As in claim 7, first or second surface of the mount is flat (Figure 4, #18). With regard to claims 8 and 9, the mount is flexible and transparent (Column 2, line 59 to Column 2, lines 23). For claim 16, the first or second surface of the mount is square or rectangular (Figures 2 and 3, #18). Regarding claim 17, the second surface of the mount does not adhere the mount to paper (Column 2, lines 10 – 16). Hendershot also discloses a mount (Abstract, lines 3 – 6) for mounting a sheet object to glass, consisting of a single layer of plastic such as PVC (Column 2, lines 10 – 16, wherein PVC is a vinyl material) and having a first surface carrying an adhesive coating which adheres the mount to a sheet object permanently or releasably to form a mountable arrangement (Figure 2, #16, 18a and 20; Column 2, lines 27 - 40) and a second surface which secures such a mountable arrangement directly to glass without adhesive (Figure 2, #18b;

Column 2, lines 10 - 16), where the first and second surfaces are mutually opposite (Figure 2, #18a and 18b) as in claim 25. With regard to claim 26, the first surface carrying an adhesive coating, adheres the mount to only a part of one surface of a sheet object to form a mountable arrangement (Figure 2 and 3, #18a). For claims 27 and 28, the first or second surface of the mount is flat, and the mount is flexible (Figure 4, #18; Column 2, line 59 to Column 2, lines 23). Regarding claim 33, the second surface of the mount does not adhere the mount to paper (Column 2, lines 10 - 16). As in claim 34, the first surface of the mount is adhered releasably to a backing material (Column 2, lines 45 - 54). With regard to claim 35, the entire surface of the mount is adhered to less than half of the area of a surface of a sheet object for permitting the said sheet object to be mounted to glass (Figure 2 and 3, #18a). Hendershot also discloses a method for securing a first material to a second material (Figure 2), comprising: releasably adhering a first surface of a mount to the first material with an adhesive coating carried by the first surface (Figure 2, #16, 18a and 20; Column 2, lines 27 - 40), wherein the mount and first material form a mountable arrangement (Figure 2, #18 and 16); and securing a second surface of the mount to the second material without adhesive (Figure 2, #18b; Column 2, lines 10 - 16), where the first and second surfaces are mutually opposite (Figure 2, #18a and 18b) and the mount consists of a single layer of plastic such as PVC (Column 2, lines 10 - 16, wherein PVC is a vinyl material) as in claim 36. Regarding claims 37 and 38, the first material is a paper-based material (Column 2, lines 45 - 54), and the second material is a glass-based material. For claim 39, the second material has a smooth surface (Figure 2, #12). Hendershot further discloses a method for securing a first material to a second material (Figure 2), comprising: adhering a first surface of a mount to a part of one surface of a sheet of paper with an adhesive coating carried by the first

surface, wherein the mount and the sheet of paper form a mountable arrangement (Column 2, lines 45 – 54); and securing a second surface of the mount to glass without adhesive (Figure 2, #18b; Column 2, lines 10 – 16), where the first and second surfaces are mutually opposite (Figure 2, #18a and 18b) and each mount consists of a single layer of plastic such as PVC (Column 2, lines 10 – 16, wherein PVC is a vinyl material) as in claim 40. Hendershot discloses a mount arrangement for mounting paper to glass comprising: a plurality of mounts (Figures 2 – 4, #18), each mount consisting of a single layer of plastic such as PVC (Column 2, lines 10 – 16, wherein PVC is a vinyl material) and having a first surface carrying an adhesive coating which adheres the mount to a sheet of paper to form a mountable arrangement (Column 2, lines 45 – 54; Figure 2, #20), and a second surface capable of securing such a mountable arrangement directly to glass without adhesive Figure 2, #18b; Column 2, lines 10 – 16); where the first and second surfaces are mutually opposite (Figure 2, #18 a and 18b).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14, 15, 18, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendershot (USPN 4,862,944).

Hendershot discloses a mount (Abstract, lines 3 – 6) releasably adhered to a single sheet of a backing material (Column 2, lines 45 – 54), the mount consisting of a single layer of plastic such as PVC (Column 2, lines 10 – 16, wherein PVC is a vinyl material) and being a mount for mounting a sheet object to glass (Figure 2, #12 and 18), and comprising a body having a first surface carrying an adhesive coating (Figure 2, #18a and 20) which adheres the mount to part of the surface of a sheet object to form a mountable arrangement (Figure 2, #16 and 20), and a second surface which secures such a mountable arrangement directly to glass without adhesive (Figure 2, #18b), wherein the film of the mount has a certain thickness. However, Hendershot fails to disclose the thickness of the mount is preferably up to 2 mm, the second surface area of the mount is in the range of about 100mm^2 to 900mm^2 and the mount comprises a pigment material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hendershot by providing its PVC cling film to have thickness of less than 2mm for flexibility and conformability, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Similarly, the film of Hendershot has a certain surface area and that the dimensions can be varied, but fails to teach that the area is 100 to 900 sqmm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilkins by providing it PVC film to have a surface area of 100 to 900 sqmm for providing optimum

coverage by the covering, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With regard to the limitation of the mount containing a pigment, Hendershot discloses that it is known to tint, or place pigment, in plastic materials (Column 1, lines 63 – 66). Since the mount is made of plastic material, it would be obvious to one of ordinary skill to add pigment to change the appearance of the mount.

Response to Arguments

7. Applicant's arguments filed October 30, 2005 have been fully considered but they are not persuasive.

Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them. No clear comparison has been made between the prior art references and the claim limitations with regard to what is being taught by the prior art and the claim limitations. Hendershot discloses a mount (Abstract, lines 3 – 6) releasably adhered to a single sheet of a backing material (Column 2, lines 45 – 54), the mount consisting of a single layer of plastic such as PVC (Column 2, lines 10 – 16, wherein PVC is a vinyl material) and being a mount for mounting a sheet object to glass (Figure 2, #12 and 18), and comprising a body having a first surface carrying an adhesive coating (Figure 2, #18a and 20) which adheres the mount to part of the surface of a sheet object to form a mountable

arrangement (Figure 2, #16 and 20), and a second surface which secures such a mountable arrangement directly to glass without adhesive (Figure 2, #18b), which is the same as structure of the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

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Primary Examiner, Art Unit 1794